



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,290	11/09/2000	Waldemar Hans	10191/1541	9759

26646 7590 02/15/2002

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

WILSON, LEE D

ART UNIT	PAPER NUMBER
----------	--------------

3723

DATE MAILED: 02/15/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,290

Applicant(s)

HANS ET AL.

Examiner

LEE D WILSON

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3723

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. The following phrases are vague, indefinite, and/or awkwardly and confusingly worded:

i. Claim 20 is improper because it is a method of manufacturing the device combined with apparatus claims. It is indefinite because how the tool is made can be a process used to make the invention or other inventions. The process make the tool should not be relied upon to make the tool patentable

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Strong (5727298).

Art Unit: 3723

Strong discloses a device having a jacket body (12), a contact section (the bottom of 20a), a collar section (18) with threaded holes (fig.1 and 22), and screws (36).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Strong (5727298).

a. Strong is discussed above.

b. Strong discloses the claimed invention except for three openings with angular distances greater than 90 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have three openings with angular distances greater than 90 degrees, as a matter of obvious design choice. *Applicant has not disclosed any advantages for solving the stated problem. There was not criticality shown for having just three openings greater than 90 degrees.*

Art Unit: 3723

6. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood (4970771) in view of Strong (5727298).

a. Wood discloses a device having a jacket body (10) and a contact section (69) with an axial extension (44) extending axially over a radial extension (44).

b. Wood does not disclose a collar section with threaded holes, and screws.

c. Strong does disclose a device having a collar section (18) with threaded holes (fig. 1 and 22), and screws (36) which allows the tool be anchored and have additional removal force provided by the screw.

d. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Wood device by providing a collar section with threaded holes, and screws as taught by Strong which allows the tool be anchored and have additional removal force provided by the screw.

Conclusion

7. While the Examiner might speculate as to what is meant by the claim language, the uncertainty provides the Examiner with no proper basis for making the comparison between that which is claimed and the prior art. Rejections under 35 U.S.C. § 103 should not be based upon considerable speculation as to the meaning of terms employed and assumptions as to the scope of the claims. *In re Steele*, 134 USPQ 292. When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim

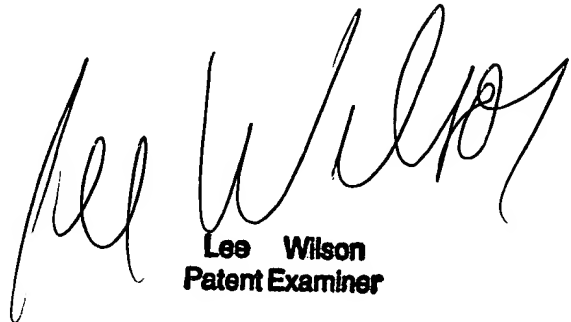
Art Unit: 3723

becomes indefinite. *In re Wilson*, 165 USPQ 494. In regard to claim 20, No prior art has been applied in view of the 112 rejections.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hintze and McMahon discloses a device.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Wilson whose telephone number is (703) 305-4094.

ldw

February 12, 2002



Lee Wilson
Patent Examiner